

## REMARKS/ARGUMENTS

The rejections presented in the Office Action dated April 29, 2008, (hereinafter Office Action) have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the § 103(a) rejections, each of which is based upon a combination of the teachings of WO 01/86997 to Varland (hereinafter "Varland") in view of "The Bayou Architecture" by Demers *et al.* (hereinafter "Demers"), because the asserted modification of Varland would improperly undermine the teachings of Varland. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01(V). Varland is directed to a proximity-based system for notifying users of other users having similar matching profiles while keeping a user's identity a secret (page 1, lines 5-8). Varland admittedly does not teach that preference profile information is received in a mobile terminal device related to one of the users because Varland instead teaches that profile information is received by a clearinghouse unit to maintain user privacy. Modifying the system of Varland to instead send the sensitive profile information to another user's terminal, as asserted, would directly undermine the privacy objective of Varland's clearinghouse unit.

Moreover, Varland is directed to matching user profiles to notify users having similar matching profiles that are in close proximity. Modifying Varland to use a local mobile terminal as a server would render the location-based profile matching impossible unless all user terminals would send their current location information to that terminal. Therefore, modifying Varland to use a local mobile server as taught by Demers would change the principle of operation of Varland in violation of MPEP § 2143.01(VI). For at least these reasons, a skilled artisan would not be motivated to modify Varland as asserted, and the asserted modification is improper.

The assertion that a skilled artisan would look to the teachings of Demers to allow Varland's proximity matching be performed without being tied to a non-mobile server is also based upon hindsight reasoning. First, Demers makes no mention of, and is unrelated to, profile matching. Second, the Bayou architecture taught by Demers is directed to user devices disconnected from a larger system (page 6, lines 8-10). A skilled artisan using common sense would not look to use Demers' Bayou architecture, which is limited to the devices disconnected from a larger network, to find other users with matching profile information in close proximity. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). Therefore, Applicant respectfully submits that the proffered motivation is a hindsight combination of prior art based on Applicant's teachings, and the requisite showing of motivation to combine Varland with Demers has not been met. Applicant accordingly requests that each of the § 103(a) rejections be withdrawn.

In addition, neither Varland nor Demers alone, or in combination, teaches or suggests each of the claimed limitations. For example, the claims not only require that a mobile terminal device receive the preference profile, the mobile terminal also compares the preference data, determines users having substantially matching preference data, and sends notifications thereof. *See, e.g.*, Claim 10. Since Varland does not teach that a mobile terminal device receives the claimed preference profile, there is no teaching or suggestion that a mobile terminal device of Varland performs other recited limitations. Also, Demers is silent with respect comparing, matching, and sending notifications regarding preference profiles in a mobile terminal as claimed. Without a presentation of correspondence to each of the claimed limitations, a § 103(a) rejection cannot be maintained.

Without acquiescing to characterizations of the asserted art, Applicant's claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant's claimed subject matter, Applicant has amended independent Claims 1 and 5 to indicate that a mobile terminal compares the preference data, determines users having substantially matching preference data, and sends notifications thereof. These limitations were already implicitly present in the claims as the claims recited that a mobile terminal device receives the preference profile. However, further support may be found in original Claim 15; therefore, the changes do not introduce new matter. At least Claims 1, 2, and 5 are believed to be further patentable over the asserted references for the reasons set forth above in connection with Claim 10.

Dependent Claims 2, 4, 6-8, 18, 19, and 20 depend from independent Claims 1 and 3, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the asserted combination of Varland and Demers. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the above remarks made in connection with the independent claims. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 4, 6-8, 18, 19, and 20 are also patentable over the asserted combination of Varland and Demers.

With particular respect to the rejection of Claims 15 and 16, Applicant traverses because the asserted combination of references fails to teach or suggest each of the claimed limitations. For example, the asserted combination of teachings does not teach a mobile terminal including means for comparing received preference data and means for sending a notification, as claimed. In contrast, the cited portions of Varland teach that a clearinghouse unit – not a mobile terminal – performs the claimed limitations. Since the further relied-

upon teachings of Demers and Taniguchi have not been asserted as teaching, or shown to teach, such limitations, any combination of such references must also fail to teach such limitations. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection of at least Claims 15 and 16 is improper, and Applicant requests that the rejection be withdrawn.

With particular respect to the rejection of Claim 17, Applicant traverses because the asserted combination of references fails to teach or suggest each of the claimed limitations. For example, the asserted combination of teachings does not teach a server mobile terminal configured to compare received preference profiles and send a notification, as claimed. Rather, the cited rejection of Claim 12 does not provide any correspondence to such limitations, and the cited rejection of Claim 15 is improper as set forth above. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection of at least Claim 17 is improper, and Applicant requests that the rejection be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (BKS.002.WUS) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC  
8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700

Date: July 1, 2008

By: 

Erin M. Nichols  
Reg. No. 57,125